

## REMARKS

Claims 6 and 8-11 are pending in this application, claim 7 having been currently cancelled and claims 10 and 11 having been added. Claims 6, 8 and 9 have been amended.

Claims 6, 8 and 9 are presented for reconsideration; claims 10 and 11 are presented for consideration.

Initially applicants note that claim 7 was cancelled and replaced by claim 10, wherein the substituents in formulae (II), (III) and (IV) are shown with subscripts to be consistent with formula (I). Claim 7 could not be readily corrected since formulae (II), (III) and (IV) were drawn with a software program that is no longer used. Newly presented claim 11 is supported by the original disclosure, especially on page 1, and by claim 6.

Applicants have amended their claims in order to more particularly point out and distinctly claim a preferred aspect of their invention, a method of inhibition of arylsulfatase on the skin of a person in need of said inhibition, which comprises applying to said skin a composition comprising an effective amount of at least one arylsulfatase-inhibiting substance selected from hydroxydiphenyl ethers of general formula (I). Amended claim 6 is supported by the original disclosure, especially on page 1, and by the exemplification. No new matter has been added.

Claims 6 and 8-9 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite, the examiner asserting that compounds of formula (I) are not necessarily hydroxydiphenyl ethers. This is not disputed. While the compounds of formula (I) are defined as hydroxydiphenyl ethers, as the examiner correctly notes, they will only be hydroxydiphenyl ethers when at least one of R<sub>1</sub>, R<sub>2</sub>, R<sub>3</sub> or R<sub>4</sub> is OH or R<sub>5</sub> is hydrogen. All of these definitions are within the scope of the original disclosure. Hence applicants aver that no new matter has been added by inserting, "with the proviso that at least one of R<sub>1</sub>, R<sub>2</sub>, R<sub>3</sub> or R<sub>4</sub> is OH or R<sub>5</sub> is hydrogen" to clarify claim 6. Every active compound of formula (I) in the formulations on pp 24-31 supports this insertion.

It is respectfully submitted that all the claims submitted for reconsideration are in good formal order. Reconsideration and withdrawal of the rejection of claims 6, 8 and 9 under 35 U.S.C. §112, second paragraph is therefore solicited.

Claims 6 and 7 (now 6 and 10) are rejected under 35 U.S.C. § 102(b) as being anticipated by Holzl et al., EP-A 1 053 989 or § 102(e) by corresponding Holzl et al., U.S. Pub. No. 2003/0162836 or 2004/0186174.

The examiner notes that Holzl et al. (collectively) discloses antimicrobial hydroxydiphenyl ethers of formula (I), and suggests that said compounds would be antimicrobially effective in a deodorant formulation such as the generic formulation shown in paragraph [0078] on page 13 of the EP. The examiner asserts that arylsulfatase inhibition is considered to be inherent and naturally occurring when said deodorants are used.

Applicants respectfully traverse this rejection for the reasons that follow.

Incorporation of compounds of formula (1) into deodorant compositions is suggested in Holzl. But no deodorant compositions were actually made. Nor are there any tests for arylsulfatase inhibition since Holzl neither teaches nor suggests arylsulfatase inhibition.

Re the assertion that arylsulfatase inhibition is considered to be inherent and naturally occurring when said deodorants are used, what is really being asserted is that if a compound of the formula (I) had been used in a deodorant, then arylsulfatase inhibition would have occurred. This equates inherency with obviousness, a clear legal error. See *In re Newell*, 13 USPQ2d (CAFC, 1990) and the many cases cited therein. All the chemical and physical properties of a class of compounds, including their physical properties, are inherent in the compounds, but that does not make those properties obvious. According to 35 U.S.C. § 101, "Whoever discovers any new and useful process ... or composition of matter may obtain a patent therefor". A new and useful method for arylsulfatase inhibition certainly meets these criteria.

Arylsulfatase is an enzyme, not a bacterium. Applicants aver that there is no relationship between antimicrobial activity and arylsulfatase inhibition. Hence the expectation that antimicrobial compounds would exhibit arylsulfatase inhibition seems based on hindsight speculation.

But speculation is certainly not a proper basis for a novelty rejection. As the Court pointed out in *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991):

Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.

Certainly, Holzl neither teaches nor suggests any method of arylsulfatase inhibition, much less that claimed. Hence there is no anticipation.

Claims 8 and 9 are rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a)/(e) as being unpatentable over Holzl et al. (EP-A 1 053 989, U.S. Pub. No. 2003/0162836 or 2004/0186174); alone, or alternatively [combined with] OTC products (Secret® or Speedstick®).

The examiner asserts that gender-specific deodorants are known in the art. Applicants do not dispute this. However they respectfully note that no ingredients are mentioned in the Speedstick® article. And arylsulfatase inhibition is certainly not mentioned therein. Nor is it mentioned in Holzl.

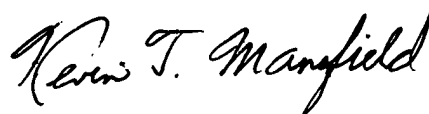
Applicants acknowledge that Mennen Speedstick® and Gillette's Right Guard® are marketed to men, and Secret® and Soft & Dri® are marketed to women in the US. But how to make and use gender-specific deodorants is not found in the applied art. Applicants aver that the sole basis for preparing gender-specific deodorants for males comprising the arylsulfatase inhibitors of formula (I) comes from hindsight of the present disclosure. But hindsight is a clearly inadequate basis for a rejection under 35 U.S.C. § 103(a).

Reconsideration and withdrawal of the rejection of claims 8 and 9 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a)/(e) as being unpatentable over Holzl et al. (EP-A 1 053 989, U.S. Pub. No. 2003/0162836 or 2004/0186174); alone, or alternatively [combined with] OTC products (Secret® or Speedstick®), is respectfully solicited in light of the remarks *supra*.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 6 and 8-11 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,



Ciba Specialty Chemicals Corporation  
540 White Plains Road  
Tarrytown, New York 10591  
(914) 785-7127  
KTM22840A1

Kevin T. Mansfield  
Agent for Applicants  
Reg. No. 31,635

Enclosure: petition for 1 month extension of time

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